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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,373	07/27/2001	Cathy S. Beyda	2001P13459US	9955

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SIEMENS CORPORATION  
Intellectual Property Department  
186 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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LE, KAREN L

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/917,373

Applicant(s)

BEYDA ET AL.

Examiner

Karen L. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-7 and 14-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13 and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of specie 4 in the reply filed on September 13, 2005 is acknowledged.

Examiner rejects specie 1 and specie 4 in the office action.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 4, 8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnard et al. (U. S. 6,859,657).

Regarding claim 1, Barnard teaches a concealed telephone system, comprising: a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2, lines 37-42 and Fig. 3, keyboard 3 and display 304) that can be hidden on the user and can make and receive telephone calls; an earpiece (Fig. 2, loudspeaker 118) that provides audio signals from the telephone to an ear of a user; and a microphone (Fig. 2, microphone 114) that receives voice signals from the user and provides them to the telephone, where each of the earpiece and microphone are camouflaged (Fig. 2).

Regarding claim 2, Barnard further teaches each of the telephone, earpiece, and microphone include short-range wireless transceivers for transmitting signals therebetween (Col. 2, lines 11-21).

Regarding claims 4 and 8, Barnard further teaches the earpiece is concealed in an article of jewelry (Fig. 2, item 118 and ring 208), microphone is concealed within an article of jewelry (Fig. 2, microphone 114 and trap 204).

Regarding claim 10, Barnard teaches the concealed telephone wherein the microphone and earpiece are connected to the telephone via a hidden wire (Col. 1, lines 24-31).

Regarding claim 11, Barnard further teaches the telephone is a cellular telephone (Col. 2, lines 37-42).

Regarding claim 12, Barnard further teaches the telephone is a wireless telephone (Col. 2, lines 37-42).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 5, 13, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard (U. S. 6,859,657).

Regarding claim 5, Barnard does not teach the article of jewelry is an earring. However Barnard teaches article of jewelry is a ring or a wrist trap (bracelet). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece and microphone elsewhere on his/her body because where the earpiece and microphone are attached is just an option of user to mount them elsewhere on his/her body.

Regarding claims 3, 13 and 18, Barnard teaches a concealed telephone system, comprising: a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2,

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lines 37-42 and Fig. 3, keyboard 3 and display 304) that can make and receive telephone calls;

an earpiece (Fig. 2, speaker 118) that provides audio signals from the telephone to an ear of a user, and

a microphone (Fig. 2, microphone 114) that receives voice signals from the user and provides them to the telephone, wherein each of the telephone, earpiece, and microphone include short-range wireless transceivers (Col. 2, lines 11-21) for transmitting signals therebetween.

Barnard does not teach a pair of glasses and an earpiece being integrated within a sidepiece of said pair of glasses. However, Barnard teaches an earpiece is integrated within a ring. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece elsewhere on his/her body because where the earpiece are attached is just an option of user to mount them elsewhere on his/her body.

Regarding claim 16, Barnard further teaches microphone is concealed within an article of jewelry (Fig. 2, microphone 114 and trap 204).

Regarding claim 19, Barnard teaches a concealed telephone system, comprising: a telephone including a keyboard and display (Fig. 1, cellular 100, Col. 2, lines 37-42 and Fig. 3, keyboard 3 and display 304) that can make and receive telephone calls;

a bracelet (Fig. 2, trap 204)

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an earpiece (Fig. 2, speaker 118) that provides audio signals from the telephone to an ear of a user, and

a microphone (Fig. 2, microphone 114) that receives voice signals from the user and provides them to the telephone, said microphone being integrated within said bracelet (Fig. 2, microphone 114 and trap 204), wherein each of the telephone, earpiece, and microphone include short-range wireless transceivers (Col. 2, lines 11-21) for transmitting signals therebetween.

Barnard does not teach said earpiece being integrated within an earring. However, Barnard teaches an earpiece is integrated within a ring. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount earpiece elsewhere on his/her body because where the earpiece are attached is just an option of user to mount them elsewhere on his/her body.

5. Claims 9, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnard (U. S. 6,859,657) in view of Taenzer et al (U. S. 6,438,245).

Regarding Barnard 9, 17 and 20, Barnard does not teach the concealed telephone of Barnard 1, wherein the telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use. However, Taenzer teaches telephone provides the ambient noise picked up by the microphone to the earpiece when the telephone is not in use (col. 3, lines 13-15). Taenaer teaches a two-way communication earpiece for use with a hearing aid, including a microphone for picking up sound ambient to the earpiece. Thus, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to incorporate Taenzer's feature to Barnard's feature to provide ambient noise picked up by the microphone when the phone is not in use.

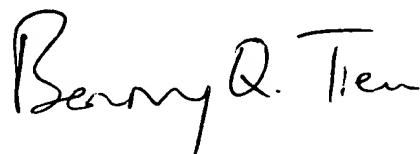
### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen L. Le whose telephone number is 571-272-7487. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen Le  
KLL  
November 28, 2005



**BENNY TIEU**  
**PRIMARY EXAMINER**

*A.U. 2642*